

REMARKS

Claims 1-7, 34-47, 58-66, 78-86, 176-184, 186-189, and 204-218 are pending. Claims 34, 58, 78, 176, and 183 have been amended. Claims 185 and 190-203 have been canceled in this response. Claims 204-218 are new. A clean copy of the pending claims incorporating Applicant's amendments is attached for the Examiner's convenience.

I. CLAIM OBJECTIONS

Claim 176 has been amended to address the Examiner's objection.

II. PRIOR ART REJECTIONS

In responding to the Examiner's prior art rejections, Applicant will only attempt to justify the patentability of his independent claims (1, 34, 58, 78, 176, 183, and 204). As the Examiner understands, should these claims be patentable over the prior art, the narrower dependent claims must also be patentable over the prior art. Hence, the patentability of the dependent claims is not separately addressed by the Applicant at this time.

A. **Claim 1**

The Examiner rejected claim 1 as anticipated by USP 5,722,526 ("Sharrard").

In Applicant's last response, Applicant explained that the Sharrard reference does not enable of the invention of Applicant's claim 1, and hence is not eligible to act as an anticipatory reference. As the Examiner's response to Applicant's arguments seems to misinterpret the enablement requirement of anticipation and/or Applicant's argument, Applicant again addresses this issue, hopefully with more clarity.

The basic issue here is that Sharrard *merely mentions* a vending machine that optically analyzes an ID card to enable a vend. Sharrard therefore superficially meets all of the limitations of claim 1. ***But this alone is not sufficient to anticipate claim 1; it must additionally be shown that Sharrard enables one skilled in the art to make and use the invention of Applicant's claim 1.*** See *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) (“Even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art [for purposes of anticipation] if it was not enabling.”). This means that Sharrard must disclose sufficient technical details concerning how one can implement (e.g., make) the optical analysis he mentions.¹

The policy for why a prior art reference must (in addition to disclosing all limitations of a claim) be enabling to qualify as an anticipatory reference is clear: for a prior art reference to anticipate another's invention, the reference must have already enriched the public with a useful invention. As explained in the MPEP:

“In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention ‘not novel’ or ‘anticipated’ within section 102, the stated test is whether a reference contains an ‘enabling disclosure’” *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). A reference contains an “enabling disclosure” if the public was in possession of the claimed invention before the date of invention. “Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention.” *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

MPEP § 2121.01.

¹ See *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1997) (emphasis added) (“To anticipate a claim, a reference must disclose every element of the challenged claim **and** enable one skilled in the art to make the anticipating subject matter.”); *Minnesota Mining & Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1306 (Fed. Cir. 2002) (“the prior art reference must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.”).

A hypothetical explains this principle. Suppose a person (e.g., author H.G. Wells) discusses in a reference the concept of using a machine to travel through time (a “time machine”). In that reference however, no useful details are disclosed as to how the time machine could be built or used—in this sense, the reference is completely hypothetical in its disclosure of a time machine. Suppose later that a person actually invents a working time machine, and claims in a patent application “A machine to travel through time.” That application discloses all of the details that one skilled in the art would need to make the time machine work. Does the earlier reference merely disclosing a time machine anticipate the claim in the later patent application? No. That reference is not enabling. By failing to provide sufficient details to one skilled in the art concerning how a time machine could be built and used, the reference has not enriched the public with that invention. Therefore, the claim is not anticipated, even though the reference superficially discloses all of the limitations of the claim.

The same situation is present here. Sharrard *mentions* optical analysis of a form, but *does not disclose any details about how such optical analysis can be effectuated*, i.e., how one of skill in the vending machine arts could make or use an optical analysis system to enable the vend. Sharrard’s disclosure as applied to optical analysis is merely hypothetical; he did not put the public in possession of a system to perform optical analysis of ID cards; he only mentioned the possibility. This is not invention of the idea of optical analysis of forms in vending machines in the eyes of the patent law, and accordingly, Sharrard’s disclosure is simply insufficient to bar Applicant from its claim, even though it superficially discloses all of the limitations of claim 1.

In its last office action response, Applicant discussed in detail exactly why Sharrard’s disclosure was insufficient from an enablement standpoint. Such discussion is not repeated here, but the Examiner is encouraged to review that response. To additionally support Applicant’s

position that Sharrard is not enabling of claim 1, Applicant submits the declaration of Mr. Lyn Barth as evidence on this point, which shows that Sharrard did not disclose sufficient technical details to allow one skilled in the vending machine arts to develop an optical card analysis system without undue experimentation, and accordingly did not put the public in possession of a working optical card analysis system for a vending machine such that one skilled in the art could make and use such a system without undue experimentation.

With the foregoing understood, the Applicant now discusses why the Examiner's stated basis for rejecting Applicant's enablement argument is incorrect. The Examiner in her latest Office Action essentially reasoned as follows: (1) Sharrard does not disclose sufficient technical details concerning how to use an optical analysis system in the context of vending machines, (2) Applicant similarly does not disclose such details in its claim language ("optically analyzing the form to electronically determine information about the consumer"), (3) thus, Applicant's claim suffers from the same lack of specificity as does Sharrard. *See* Office Action of Oct. 21, 2003 at 10.

But this logic is faulty and confuses concepts. The level of technical make/use details in Applicant's claim language is irrelevant to the specificity of Sharrard's disclosure, the relevant issue to be decided. *See S3 Inc. v. NVIDIA Corp.*, 259 F.3d 1364, 1369 (Fed. Cir. 2001) ("The purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant."). Applicant can claim as broadly as possible, subject to the various rules of patentability (novelty § 102, obviousness § 103, enablement § 112, etc.). Thus, the level of specificity in Applicant's claims is not the issue; the issue is whether Sharrard enables the scope of Applicant's claims, which as mentioned above, it does not.

B. Claim 34 and New Claim 204

The Examiner rejects claim 34 for obviousness given the combination of USP 5,386,103 (“DeBan”) and USP 6,032,859 (“Muehlberger”).

To distinguish from these references, claim 34 has been amended to recite that the memory device stores templates “for a plurality of different types of forms,” which might be for example a Texas and an Indiana driver’s license, or a California license and a U.S. passport. Moreover, as claimed and amended, these templates assist the claimed system in determining which of those types of forms has been put into the form reader. Neither of these concepts (templates for different types of forms; determining which form has been used) are disclosed in DeBan or Meuhlberger, which seem capable of handling and determining only a single prescribed type of form. Accordingly, even when taken in combination, these references cannot render claim 34 obvious because that combination does not disclose all limitations of claim 34. See MPEP § 2143.

Claim 190 was also rejected given the combination of DeBan or Meuhlberger. Claim 190 has been canceled and essentially rewritten as method claim 204. Claim 204 recites in part inputting one of a plurality of different types of forms into a card reader; taking an optical image of the form, and “analyzing the optical image to determine which of the plurality of different types of forms has been received by the system and to determine consumer information therefrom.” As noted above with respect to claim 34, neither DeBan or Meuhlberger disclosed multiple-form assessment capability. Accordingly, even when taken in combination, these references cannot render claim 204 obvious because that combination does not disclose all limitations of claim 204. See MPEP § 2143.

C. Claims 58 and 78

The Examiner rejects claims 58 and 78 for obviousness given the combination of USP 5,450,938 (“Rademacher”) with Muehlberger and Sharrard.

In response, Applicant has amended his claims to recite the same sort of “multiple-form capability” described above with respect to claims 34 and 204. Such capability is not disclosed or suggested in any of the cited references. Accordingly, even when taken in combination, the cited references do not disclose all of the limitations of Applicant’s claims, and therefore cannot render claims 58 and 78 obvious. See MPEP § 2143.

E. Claim 176

The Examiner rejected claim 176 as anticipated by USP 5,722,526 (“Sharrard”). In this regard, the Examiner noted that the driver license used in the Sharrard patent constituted “*one* of a plurality of different types of forms.”

Applicant has amended claim 176 to make more explicit the “multiple-form capability” described above by specifying that optical analysis of the form includes “electronically determine[ing] which of the plurality of different types of forms has been received by the system.” As discussed above, this capability is not disclosed in any of the cited references, and specifically is not disclosed or suggested in Sharrard. Moreover, because Sharrard is not an enabling prior art reference on the point of optical analysis as stated above, claim 176 cannot be anticipated by Sharrard in any event. Applicant thus submits that claim 176 is now patentable.

F. Claim 183

The Examiner rejected claim 183 as anticipated by USP 5,722,526 (“Sharrard”).

Applicant has amended claim 183 to incorporate the limitations of dependent claim 185 (now canceled) which specifies that optically analyzing the form comprises “scanning the form to produce an image and comparing the image to image templates.” Whatever Sharrard discloses

by way of optical analysis, it is clear that Sharrard does not expressly disclose or suggest the use of templates.

Moreover, Applicant now specifically claims using optical analysis to authenticate the form, a concept not disclosed in Sharrard.

Moreover, it is not fair to conclude that such disclosure is *implicit* in Sharrard, as the examiner seems to have done. As stated in the MPEP:

The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristics. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill. Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

MPEP § 2112 (citations and quotations omitted) (emphasis in original). If the Examiner wishes to continue to reject this claim on the basis of inherent disclosure of the use of templates in Sharrard, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic [i.e., use of templates] *necessarily* flows from [Sharrard].” *Id.* (emphasis in original). In any event, the Examiner should appreciate that optical analysis can be performed without the use of templates, and therefore that this claim limitation is not *necessarily* (inherently) disclosed in Sharrard.

In short, Sharrard does not expressly or inherently meet the amended limitations in claim 183. Moreover, because Sharrard is not an enabling prior art reference on the point of optical analysis as stated above, claim 183 cannot be anticipated by Sharrard in any event. Applicant thus submits that claims 183 is now patentable.

* * * * *

Applicant submits that pending claims 1-7, 34-47, 58-66, 78-86, 176-184, 186-189, and 204-218 are patentable over the prior art of record, and requests that a Notice of Allowance be issued for these claims. The Examiner is welcome to contact the undersigned (832-446-2422) to discuss this application.

Respectfully submitted,



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Clean Copy of Pending Claims

1. (original) A method for determining information about a consumer prior to enabling the vending of a good or service from a machine, comprising:
 - (a) receiving a form containing information about the consumer at the machine;
 - (b) optically analyzing the form to electronically determine information about the consumer; and
 - (c) enabling the vend on the basis of the information.
2. (original) The method of claim 1, wherein the form is selected from the group consisting of an identification card, a driver's license, a social security card, and a passport.
3. (original) The method of claim 1, wherein optically analyzing the form comprises scanning the form to produce an image and comparing the image to image templates.
4. (original) The method of claim 3, wherein the image templates are transmitted to the machine by a system.
5. (original) The method of claim 1, wherein the determined information is selected from the group consisting of the consumer's age, date of birth, name, address, identification number, driver's license number, social security number, and passport number.
6. (original) The method of claim 5, wherein vending is enabled if the consumer is of a suitable age to purchase the good or service.
7. (original) The method of claim 1, wherein the machine is selected from the group consisting of a vending machine, an automatic teller machine, a cash register, and a gas pump.
- 8-33. (canceled)

34. (previously and currently amended) A system, comprising:
- (a) at least one terminal containing a form reader for taking an optical image of a consumer identification form; and
 - (b) at least one memory device within the at least one terminal for storing templates for a plurality of different types of forms to assist in the analysis of the optical image to determine therefrom the type of form and consumer information.
35. (original) The system of claim 34, further comprising a server in communication with the at least one terminal.
36. (original) The system of claim 35, wherein the server provides the templates to the memory device.
37. (original) The system of claim 35, wherein the server receives data from the terminal.
38. (previously amended) The system of claim 37, wherein the data is selected from the group consisting of Direct Exchange information, information concerning the contents of the terminal, consumer account information, and consumer credit card information.
39. (previously amended) The system of claim 34, wherein the at least one terminal is a vending machine, and further comprising an enabling circuit for receiving the consumer information to enable the vending of goods or services from the terminal.
40. (original) The system of claim 34, wherein the consumer information is selected from the groups consisting of the consumer's age, date of birth, name, address, identification number, driver's license number, social security number, and passport number.
41. (original) The system of claim 34, wherein the at least one terminal is a gas pump, and further comprising an enabling circuit for receiving the consumer information and enabling the vending of gasoline from the terminal accordingly.

42. (original) The system of claim 41, wherein the consumer information comprises information indicative of the validity of the consumer's driver's license.

43. (original) The system of claim 35, further comprising at least one integrated system in communication with the server.

44. (original) The system of claim 43, wherein the integrated system is selected from the group consisting of credit card databases, governmental law enforcement databases, consumer reporting agency databases, and financial services system databases.

45. (previously amended) The system of claim 35, wherein the server communicates with a plurality of consumer accounts accessible in accordance with the consumer information.

46. (original) The system of claim 35, wherein the system comprises at least two different types of terminals.

47. (original) The system of claim 46, wherein the types of terminals are selected from the group consisting of a vending machine, an automatic teller machine, a cash register, and a gas pump.

48-57. (canceled)

58. (previously and currently amended) A method for allowing a consumer to pay for a good or service having a purchase price at a vending machine using a system, the method comprising:

- (a) receiving at the system consumer account registration information to establish at least one electronic consumer account accessible by the system;
- (b) receiving a form containing information about the consumer into the vending machine, wherein the form constitutes one of a plurality of forms receivable by the system;

- (c) optically analyzing the form to electrically determine which one of the plurality of different types of forms has been received at the system and to determine information about the consumer; and
- (d) using the information to electronically charge the purchase price from the at least one consumer account.

59. (original) The method of claim 58, wherein establishing an electronic consumer account comprises communicating with the system using a computerized user interface.

60. (original) The method of claim 58, wherein the form is selected from the group consisting of an identification card, a driver's license, a social security card, and a passport.

61. (original) The method of claim 58, wherein optically analyzing the form comprises scanning the form to produce an image and comparing the image to image templates.

62. (original) The method of claim 58, wherein the determined information is selected from the group consisting of the consumer's age, date of birth, name, address, identification number, driver's license number, social security number, and passport number.

63. (original) The method of claim 58, wherein the at least one consumer account comprises a credit card account.

64. (original) The method of claim 58, wherein the at least one account resides on an integrated system in communication with the system.

65. (previously amended) The method of claim 58, wherein the at least one account comprises a plurality of accounts, and further comprising allowing the consumer to select one of the plurality of accounts prior to using the information to electronically charge the purchase price from the at least one consumer account.

66. (original) The method of claim 58, further comprising enabling the consumer to enter a private key prior to charging the at least one consumer account.

67-77. (canceled)

78. (previously and currently amended) A system for accessing at least one consumer account registered with a system, comprising:

- (a) at least one terminal for receiving a form containing information about a consumer and for producing an optical image of the form, wherein the form constitutes one of a plurality of forms receivable by the system;
- (b) a program for analyzing the optical image to determine which one of the plurality of different types of forms has been received at the system and to determine consumer information therefrom; and
- (c) at least one integrated system in communication with the system which contains at least one consumer account, wherein the at least one consumer account is accessible using the determined consumer information.

79. (original) The system of claim 78, further comprising a user interface to allow the at least one consumer account to be preregistered with the system.

80. (original) The system of claim 78, wherein the form is selected from the group consisting of an identification card, a driver's license, a social security card, and a passport.

81. (original) The system of claim 78, wherein the program compares the image to image templates.

82. (original) The system of claim 78, wherein the determined information is selected from the group consisting of the consumer's age, date of birth, name, address, identification number, driver's license number, social security number, and passport number.

83. (original) The system of claim 78, wherein the at least one consumer account comprises a credit card account.

84. (original) The system of claim 78, further comprising a server disposed between and in communication with the at least one terminal and the at least one integrated system.

85. (original) The system of claim 78, wherein the system comprises at least two different types of terminals.

86. (original) The system of claim 85, wherein the types of terminals are selected from the group consisting of a vending machine, an automatic teller machine, a cash register, and a gas pump.

87-175. (canceled).

176. (previously added; currently amended) A method for determining information about a consumer prior to enabling a vending of a good or service from a machine, comprising:

- (a) receiving a form containing information about the consumer at the machine, wherein the form is one of a plurality of different types of forms receivable by the system;
- (b) optically analyzing the form to electronically determine which of the plurality of different types of forms has been received by the system and to electronically determine information about the consumer; and
- (c) enabling the vend on the basis of the information.

177. (previously added) The method of claim 176, wherein the form is selected from the group consisting of an identification card, a driver's license, a social security card, and a passport.

178. (previously added) The method of claim 176, wherein optically analyzing the form comprises scanning the form to produce an image and comparing the image to image templates.

179. (previously added) The method of claim 178, wherein the image templates are transmitted to the machine by a system.

180. (previously added) The method of claim 176, wherein the determined information is selected from the group consisting of the consumer's age, date of birth, name, address, identification number, driver's license number, social security number, and passport number.

181. (previously added) The method of claim 180, wherein vending is enabled if the consumer is of a suitable age to purchase the good or service.

182. (previously added) The method of claim 176, wherein the machine is selected from the group consisting of a vending machine, an automatic teller machine, a cash register, and a gas pump.

183. (previously added; currently amended) A method for determining information about a consumer prior to enabling the vending of a good or service from a machine, comprising:

- (a) receiving a form containing information about the consumer at the machine;
- (b) optically analyzing the form using optical character recognition algorithms to electronically determine information about the consumer and to authenticate the form, wherein optically analyzing the form comprises scanning the form to produce an image and comparing the image to image templates; and
- (c) enabling the vend on the basis of the information.

184. (previously added) The method of claim 183, wherein the form is selected from the group consisting of an identification card, a driver's license, a social security card, and a passport.

185. (canceled)

186. (previously added) The method of claim 185, wherein the image templates are transmitted to the machine by a system.

187. (previously added) The method of claim 183, wherein the determined information is selected from the group consisting of the consumer's age, date of birth, name, address, identification number, driver's license number, social security number, and passport number.

188. (previously added) The method of claim 187, wherein vending is enabled if the consumer is of a suitable age to purchase the good or service.

189. (previously added) The method of claim 183, wherein the machine is selected from the group consisting of a vending machine, an automatic teller machine, a cash register, and a gas pump.

190-203. (canceled)

204. (new) A method, comprising:

- (a) inputting a consumer identification form into a card reader in a terminal, wherein the form is one of a plurality of different types of forms receivable by the system;
- (b) taking an optical image of a consumer identification form; and
- (c) analyzing the optical image to determine which of the plurality of different types of forms has been received by the system and to determine consumer information therefrom.

205. (new) The method of claim 204, further comprising a server in communication with the terminal.

206. (new) The method of claim 205, wherein the server provides templates to the terminal to assist in analyzing the optical image.

207. (new) The method of claim 205, wherein the server receives data from the terminal.

208. (new) The method of claim 207, wherein the data is selected from the group consisting of DEX information, information concerning the contents of the terminal, consumer account information, and consumer credit card information.

209. (new) The method of claim 204, wherein the terminal is a vending machine, further comprising vending of goods or services from the terminal on the basis of the consumer information.

210. (new) The method of claim 204, wherein the consumer information is selected from the group consisting of the consumer's age, date of birth, name, address, identification number, driver's license number, social security number, and passport number.

211. (new) The method of claim 204, wherein the terminal is a gas pump, and further comprising enabling the vending of gasoline from the terminal on the basis of the consumer information.

212. (new) The method of claim 211, wherein the consumer information comprises information indicative of the validity of the consumer's driver's license.

213. (new) The method of claim 205, further comprising at least one integrated system in communication with the server.

214. (new) The method of claim 213, wherein the integrated system is selected from the group consisting of credit card databases, governmental law enforcement databases, consumer reporting agency databases, and financial services system databases.

215. (new) The method of claim 205, wherein the server communicates with a plurality of consumer accounts accessible in accordance with the consumer information.

216. (new) The method of claim 204, wherein the terminal contains templates to assist in analyzing the optical image.

217. (new) The method of claim 58, wherein the form does not comprise a credit or debit card.

218. (new) The system of claim 78, wherein the form does not comprise a credit or debit card.